

## REMARKS

### Status of the Claims

#### *Pending claims*

Claims 3, 5 to 10, 12 to 14, 16 to 20, 22, 45, 46, 48 to 50, 52 to 54, 56, 58 and 59 are pending.

Applicants last response was a Request for continued examination (RCE) under 37 C.F.R. §1.114, submitted December 17, 2003. In that response, new claims 61 to 116 were added, and claims 2, 4, 11, 44, 47, 51, 55, 57 and 60 were canceled, without prejudice.

### The Restriction Requirement

This is a second restriction requirement. The first restriction requirement was issued on November 08, 1999. In the first restriction requirement, the Patent Office alleged that the pending claims of the application were directed to four separate and distinct inventions under 35 U.S.C. §121. In Applicants' response of January 24, 2000, Group I, drawn to a functional site descriptor, was elected, with traverse. In that response, Applicants set forth distinct and specific errors in the restriction requirement and reasons for the Patent Office to reconsider and withdraw, in part, the restriction requirement. Accordingly, Applicants preserved their right to petition the restriction to the Group Director under 37 CFR §1.144; see also MPEP §818.03(c); pg 800-60, 8th Edition, August 2001.

In this second restriction requirement, the Patent Office alleged that the pending claims of the application were directed to three separate and distinct inventions under 35 U.S.C. §121, as follows, referring only to independent claims:

Group I: claims 53, 59 and 20, drawn to a descriptor of a functional site of a protein;

Group II: claims 45, 54, 56, 58, 92, 105, 106, drawn to methods of creating or defining or determining of a descriptor of a functional site of a protein.

Group III: claims 53, 59 and 20, drawn to a computer system.

### The Election

In response to the Restriction Requirement, Applicants re-elect Group I, drawn to a descriptor of a functional site of a protein (or, as worded in the first restriction requirement, drawn to a functional site descriptor).

Applicants respectfully request that, after the elected product claims (descriptor of a functional site of a protein) have been found to be allowable, all withdrawn process (methods) claims which depend from or otherwise include all of the limitations of the allowed product claims be rejoined. MPEP §821.04; pg 800-63, 8th Edition, August 2001; In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995); In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1995); 1184 OG 86, 3/26/96.

### Reasons to reconsider and withdraw restriction requirement

Applicants respectfully request the Patent Office reconsider and, in part, withdraw the restriction requirement for the following reasons:

Applicants incorporate herein their response of January 24, 2000, electing Group I, drawn to a functional site descriptor, where they set forth distinct and specific errors in the restriction requirement and reasons for the Patent Office to reconsider and withdraw, in part, the restriction requirement, to preserve their right to petition the restriction to the Group Director under 37 CFR §1.144.

Furthermore, Applicants respectfully aver that after a complete search directed to the claimed functional site descriptors of Group I, it would not be an undue burden for the Patent Office to also do a complete search for corresponding methods of creating or defining or determining of a descriptor of a functional site of a protein (functional site descriptors of the invention). Accordingly, Applicants respectfully request the Patent Office to rejoin all claims directed to functional site descriptors of the invention and methods of creating or defining or determining functional site descriptors of the invention into one restriction group.

Applicants respectfully aver that after a complete search directed to the claimed functional site descriptors of Group I, it would not be an undue burden for the Patent Office to also do a complete search for corresponding computer system comprising functional site descriptors of the invention. Accordingly, Applicants respectfully request the Patent Office to

Applicant : Skelnick et al.  
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rejoin all claims directed to functional site descriptors of the invention and computer systems comprising functional site descriptors of the invention into one restriction group.

It is believed that the all claims pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

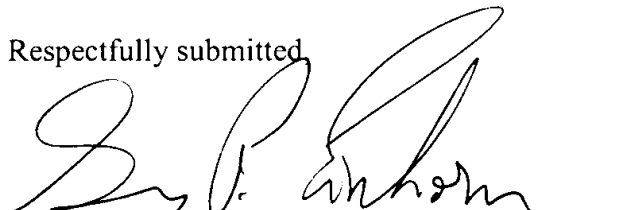
If an additional fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 06-1050. Please credit any overpayment to the above-noted Deposit Account.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858 678 5070.

Respectfully submitted

Date:

*Sept. 5, 2003*



Gregory P. Einhorn  
Reg. No. 38,440

Fish & Richardson P.C.  
4350 La Jolla Village Drive, Suite 500  
San Diego, California 92122  
Telephone: (858) 678-5070  
Facsimile: (858) 678-5099